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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,950	12/18/2001	Harri Korpela	059643.00139	5366

32294 7590 03/05/2008
SQUIRE, SANDERS & DEMPSEY L.L.P.
14TH FLOOR
8000 TOWERS CRESCENT
TYSONS CORNER, VA 22182

EXAMINER

NGUYEN, STEVEN H D

ART UNIT	PAPER NUMBER
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2619

MAIL DATE	DELIVERY MODE
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03/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/028,950
Filing Date: December 18, 2001
Appellant(s): KORPELA ET AL.

Peter Flanagan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01/07/2008 appealing from the Office action mailed 09/04/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The brief is deficient because the specification does not state an

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arrangement being a network model stool as stated in page 8, lines 1-5 and page 8, line 20 to page 9, line 1.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 30-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose a software tool "a network model tool" to perform the functions of the claims.

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3. Claims 21-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As claim 21, line 3, line 11, claims 22, 24, line 2, claim 30, line 3, line 9, claims 31, 33, line 1, claim 39, line 3, lines 1-11, claims 40, 42, line 1, "technical solutions" is vague and indefinite because it's unclear what it's constituted for. Please clarify, so the meter and boundary of the claims can be determined.

As claims 21, 30 and 39, "providing a comparison of different technical solutions to a user based on the modeling" is vague and indefinite because it's unclear what a comparison of different technical solutions is provided to a user. Please clarify, so the meter and boundary of the claims can be determined.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 21-47 rejected under 35 U.S.C. 101 because is directed to non-statutory subject matter. The claimed invention is not limited to a practical application. Viewed as a whole, the claimed invention merely expresses a method, tool and system for providing a comparison of a value to a user therefore, the claimed invention is not practical applied. The other three § 101 classes of machine, compositions of matter and manufactures can be group as product claims, and the product classes have required physical structure or material. The claims do not itself perform any useful concrete, physical transform and tangible result, i.e., no post solution activity, and thus does not fit within the definition of a machine.

(10) Response to Argument

In the appeal brief, the appellant states that (1) software tool is not a network model which is disclosed in the specification by a word "arrangement"; (2) "arrangement" which is a network model tool, mean a general purpose computer programmed to execute software modules or an application specific integrated circuit according to one of ordinary skill in the art; (3) the invention is not a manual process; (4) "technical solutions" which is a broad term "breadth claim", is not vague and indefinite and (5) claims 21-47 is statutory because the independent claims provide a comparison of different technical solutions to a user based on the modeling.

With respect to (1), the appellant states that software tool is not a network model tool which is disclosed in the specification by a word "arrangement". In reply, the examiner respectfully disagrees with the applicant because the specification does not disclose a network model tool which implements by the computer codes "software tool" to perform the functions of the claims. The specification only discloses a manual process to perform the claimed invention by using an arrangement or method.

With respect to (2), the appellant states that "arrangement" which is a network model tool, mean a general purpose computer programmed to execute software modules or an application specific integrated circuit according to one of ordinary skill in the art. In reply, the examiner respectfully disagrees with the applicant because the applicant does not provide any fact such as prior art or paper, to indicate that one of ordinary skill in the art understands that an arrangement is a software or program product as stated by the applicant.

With respect to (3), the appellant states that the invention is not a manual process. In reply, the examiner respectfully disagrees with the applicant because the specification does not

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disclose a software or program product to perform the functions of the claims. The specification only discloses that a manual work often uses to handle a process and expansion of a network in parallel. However, no single manual work to handle both the process and expansion of a network. It clearly does not disclose a software network model tool to implement the functions of the claims because the applicant does not provide any fact such as prior art or paper, to indicate that one of ordinary skill in the art understand that an arrangement is a software or program product as stated by the applicant.

With respect to (4), the appellant states that "technical solutions" which is a broad term, is not vague and indefinite. In reply, the examiner agrees with the applicant that a breadth claim which contains a broad term is not indefinite or vague. The claims which contain "technical solutions" are the undue breadth claims because the term is too broad. For example, what is it mean for technical solution such hardware, software etc. Therefore, one of ordinary skill in the art can not determine a meter and boundary of the claims or undue the technical solutions of the claims because the term made the claims too broad.

With respect to (5), the appellant state that claims 21-47 is statutory because of providing a comparison of different technical solutions to a user based on the modeling which discloses in the independent claims is similar to provide a value "share price" to a user according to In state Street Bank & trust Co. v. Signature Financial Group Inc., 47 USPQ2D 1596, AT 1601-02 (Fed. Cir. 1998). In reply, the examiner respectfully disagrees with the applicant because of providing a comparison of different technical solutions to a user based on the modeling is not similar to provide a share value to a user. Since, a step of providing a comparison of different technical solutions to a user based on the modeling is not final price which calculates by physical

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or the steps of process because it only give a user the different between the technical solutions in order to allow a user to select a best technical solution. Therefore, the claim is not statutory because providing a comparison of different technical solutions to a user is not a final result.

(11) Related Proceeding(s) Appendix


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Steven Nguyen

STEVEN NGUYEN
PRIMARY EXAMINER



Conferees:

Chau Nguyen

Chi Pham

CHAU NGUYEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800



CHI PHAM
SUPERVISORY PATENT EXAMINER

